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	First Named Inventor	Smith, Mary
	Art Unit	3722
	Examiner Name	Henderson, Mark T.
Total Number of Pages in This Submission	Attorney Docket Number	83317.000004

**ENCLOSURES (check all that apply)**

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| <input type="checkbox"/> Fee Transmittal<br><input checked="" type="checkbox"/> Fee Attached – Fee required for filing Appeal Brief – Check # <u>108270</u> for \$170.00<br><input type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavit/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input type="checkbox"/> Information Disclosure Statement<br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Response to Missing Parts/Incomplete Application<br><input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance communication to Group<br><input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences<br><input checked="" type="checkbox"/> Appeal Communications to Group (Appeal Brief in Triplicate)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):<br>Acknowledgement Postcard |
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Date	November 8, 2004

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## PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Smith, Mary

Atty. Docket: 83317.000004

Serial No.: 09/391,869

Examiner:

Filed: September 8, 1999

**Art Unit:**

Title: POCKET INSERT FOR BOUND BOOK

Appeal Brief Pursuant to 37 C.F.R. §1.192

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

## 1. REAL PARTY IN INTEREST

The present application was originally assigned to Monroe Graphics, Inc. now Evolution Impressions.

## 2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to appellants, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### 3. STATUS OF CLAIMS

Claims 1-21 and 26-36 are pending in the application, wherein Claims 26-31 have been withdrawn from consideration, and Claims 1-21 and 32-36 are finally rejected and subject to the present appeal.

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#### 4. STATUS OF AMENDMENTS

No amendments subsequent to the final action have been filed.

#### 5. SUMMARY OF INVENTION

The present invention is a pocket insert for operably passing through a printer or a copier in sequence with a single sheet of paper having a given width and a given length (p. 6, lines 15-18 and 30-32); p. 7, lines 3-10; Figures 2-7), comprising

(a) a base sheet (p. 4, lines 6-7; reference 10 in Figures 2-5 and 2-6) having a single thickness (one ply) and a binding edge (p. 4, lines 11-3; reference 12 in Figures 2-5) at an end of the sheet, the base sheets have a width equal to the given width and a length equal to the given length (page 3, lines 15-18; Figure 7) and preferably, a length and width comparable in size to a book page (p. 5, lines 18-23);

(b) a pocket sheet (p. 4, lines 15-18; reference 20 in Figures 2, 3 and 5) having a single sheet thickness (one ply);

(c) an adhesive (p. 4, lines 18-25) between the base sheet 10 and the pocket sheet 20 to bond the base sheet to the pock sheet along a continuous, two-ply seam (p. 3, lines 7-19; p. 4, lines 6-22; p-5, lines 1-7 [all as amended]; Figure 2) to form a pocket with an opening (p. 4, lines 30-32; shown as 41 in Figures 2-5) with an opening facing the binding edge;

(d) the pocket insert having a maximum thickness equal to a combined thickness of the single thickness, the single sheet thickness and adhesive. (Page 3, replacement the paragraph extending from lines 7-19; Figures 2-6).

## 6. ISSUES

1. Whether Claims 1-9, 11-13, 16-18 and 32-34 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over Wyant (US Patent 5,823,573)<sup>1</sup> in view of Dick (US Patent 1,495,953).
2. Whether Claims 10, 14, 15, 19-21 and 36 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over Wyant in view of Dick (U.S. Patent 1,495,953) further in view of Ruebens (US Patent 4,965,948)<sup>2</sup>.
3. Whether Claim 35 is properly rejected under 35 U.S.C. §102(b) as being unpatentable over Michelin (US Patent 5,141,252).

## 7. GROUPING OF CLAIMS

Claims 1-4, 6, 7, 9, 11-13, 16-18 stand or fall together.

Claim 5 stands or falls alone.

Claim 8 stands or falls alone.

Claims 10, 14, 15 and 19-21 stand or fall together.

Claim 32 stands or falls alone.

Claim 33 stands or falls alone.

Claim 34 stands or falls alone.

Claim 35 stands or falls alone.

Claim 36 stands or falls alone.

## 8. ARGUMENT

### *(i) Rejections under 35 U.S.C. §112, First Paragraph.*

There are no outstanding objections under 35 U.S.C. §112, first paragraph.

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<sup>1</sup> Applicant notes the patent to Wyant is identified on the Notice of References cited as US 5,540,513, and the US patent 5,823,573 names Chang as the inventor. In view of the examiner's description of Wyant, (US Patent 5,540,513), applicant has treated the rejection as being based upon Wyant (US patent 5,540,513) in view of Dick.

<sup>2</sup>As set forth above, applicant has taken this rejection to rely upon Wyant, US Patent 5,540,513.

*(ii) Rejections Under 35 U.S.C. §112, second paragraph*

There are no outstanding rejections under 35 U.S.C. §112, second paragraph.

*(iii) Rejections Under 35 U.S.C. §102*

Claim 35 stands rejected under 35 U.S.C. §102(b) as being anticipated by Michlin (US Patent 5,141,252).

Michlin discloses a magazine pocket insert that can be glued or stapled in place when the plies of the magazine are assembled. The insert has a multi-ply portion that forms the pocket of a return mailer.

Rejected Claim 35 contains a limitation that the pocket insert of the invention has “a thickness rendering the insert passable through a copier or printer in sequence with a sheet of paper” having the same width and length as the base sheet of the insert, that is, a sheet apart from the insert per se. The Examiner has referred to Col. 3, lines 15-18 of Michlin as disclosing “a pocket insert capable of passing through a printer”.

However, the cited passage of Michlin merely indicates that to enhance use of his magazine insert “the back surface of the back ply can be preprinted.” Saying only that the “back ply can be preprinted” does not equate to a disclosure or a suggestion that the pocket insert itself and as a whole is of a thickness passable through a printer or copier in sequence with a sheet of paper having the same size as the base sheet.

For example, there is no indication of when the Michlin back ply is in a printable condition; is it before the insert is made or after? The Examiner makes the assumption that the ability to pass through the printer is after assembly of the insert.

However, there is no definitive support or enabling disclosure for this assumption. Neither is there support for asserting that if the insert (which is two plies thick) is printed after assembly it nevertheless has a thickness allowing it to be printed in sequence with a single ply having the same length and width as the insert.

If, on the other hand, the back ply is printed before assembly, then the recited limitation of the entire insert being passable through the printer or copier is lacking from the reference.

The Examiner has discounted the claimed thickness limitation as being a recitation of the intended use of the claimed invention. This is not so; the limitation is a structural limitation that defines the overall thickness of the pocket insert of the invention and is a further limitation to the recitation of the insert thickness “being at its maximum equal to the combined thickness of the base sheet single thickness, the pocket sheet single thickness and the adhesive.”

Thus, the claim limitation does not define an intended use; it defines a maximum thickness; a structural feature of the insert. This is similar to a recitation of size of a wheel chair having a leg portion “so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof.” *Orthokinetics Inc. v. Saftey Travel Chairs Inc.*, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

The Examiner makes the definitive statement that “the pocket insert of Michlin is capable of being passable through a printer in sequence with a sheet of paper”. This is predicated on the Examiner’s position that the prior structure (Michlin) is capable of performing the intended use. As Applicant has shown, there is nothing in Michlin to indicate that the Michlin magazine insert is passable through a printer or copier in sequence with a single sheet having the same length and width of the base sheet so there is no basis for the assertion.

As the Examiner points out, Michlin does say at Col. 2, lines 40-46 that the pocket insert can be made by folding a single sheet to form the two plies of the insert. Even so, there is no disclosure that the single sheet when so folded is able to pass through a printer. That is, a folder line has a greater thickness than the respective sheets.

The Examiner relies upon Michlin to disclose “a pocket insert capable of passing through a printer (Col. 3, lines 15-18)”

Applicant has respectfully reproduced this section of Michlin which does not disclose or suggest that the pocket insert is capable of passing through a printer. Rather, a single ply (the back ply 16) can be *preprinted*.

In order to enhance use of the multi-ply insert as a 15 mailer, the back surface of the back ply 16 can be pre-printed with reply address information 21 and postal indicia 22 so as to be conveniently mailed. (Col. 3)

That is, preprinted clearly suggests printing before the ply is incorporated.

Further, the Examiner has not accounted for the specific inclusion in Michlin of the insert ply at 18 (Col. 2, lines 40-42).

As seen in Figure 2, the multi-ply portion 14 is formed of back ply 16, insert ply 18 and front ply 17, thereby forming a three-ply structure. As this is expressly contrary to the recited two ply structure of Claim 35, Applicant respectfully submits the asserted rejection cannot be sustained.

For a rejection under 35 U.S.C. §102(b) to stand, each element of the rejected claim must be found in a single reference.

As Michlin fails to disclose the claimed thickness limitation, the rejection cannot be sustained.

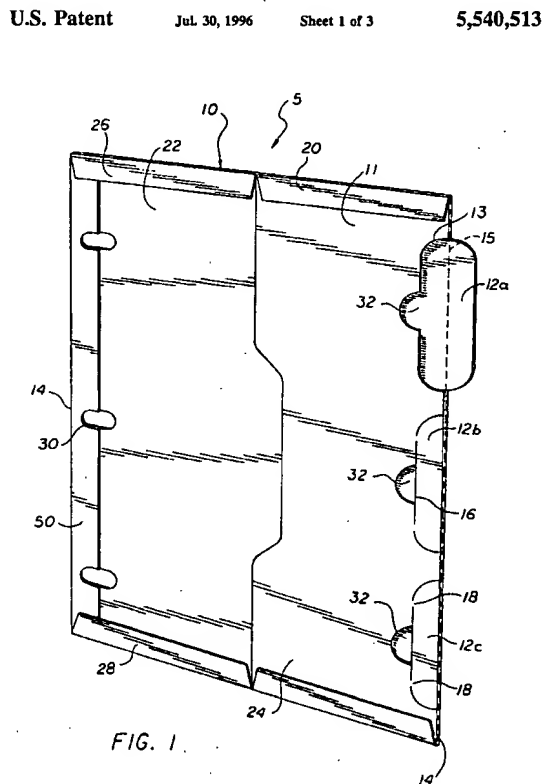
*(iv) Rejections Under 35 U.S.C. §103*

Claims 1-9, 11-13, 16-18 and 32-34 stand rejected under 35 U.S.C. §103 as being unpatentable over Wyant (US Patent 5,540,513) in view of Dick (US Patent 1,495,953).

Wyant discloses a file indexing system having a tab-yielding panel, construed as the pocket sheet 11 by the Examiner.

As seen in Wyant, the “pocket” formed by Wyant is open bottomed. That is, the bottom of each “pocket” has a rupture tear line 16 to facilitate breakage of the tear line and open the tab 12. (Wyant, Col. 2, line 62—Col. 3, line 8). Thus, Wyant discloses an arrangement for facilitating the making of a through passage. The Examiner is relying upon a through passage (as shown by Wyant) to disclose a pocket.

Applicant respectfully submits a tunnel is not a pocket.



The Examiner points out that until Wyant tabs 12 are deployed, the pocket is considered to be in a closed state.

However, as last amended Claim 1 recites that the seams forming the closed pocket are “continuous two-ply seams.” As further noted below, the Wyatt seams are neither continuous nor two ply.

Examiner Henderson recognizes Wyant does not disclose:

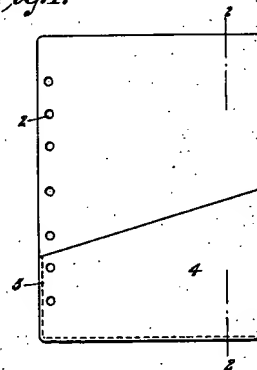
1. a pocket sheet perimeter defined by an attached edge section on the inner surface;



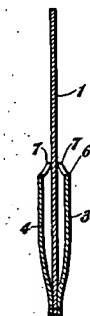
2. wherein the attached edge section of the pocket sheet perimeter is attached through bonding, fusing or gluing to the first surface along a plurality of seams to form a continuous two ply seam defining a pocket with a closed end (the Wyatt seams are three plies along opposite sides, two plies along a folded side and are not continuous, see openings formed at 12a, 12b and 12c);
3. wherein the pocket has a width at least 60% of the width of the base sheet;
4. wherein the pocket and the base sheet are separate sheets;
5. wherein the base sheet and the pocket sheet are adhered along respective edges;
6. wherein the base sheet and the pocket sheet are formed of a rectangular sheet having particular sizes;
7. a front and a back cover, wherein the pocket inserts are bound between the covers; and
8. wherein the pocket retained supplemental media.

The Examiner relies upon Dick (US Patent 1,495,953) to cure these eight (8) deficiencies of the primary reference Wyant. Specifically, the Examiner asserts Dick discloses a pocket insert "at a particular location" having a pocket sheet (4) perimeter defined by an attached edge section on the inner surface to a base sheet (1) through "any securing means" along a plurality of seams (5) to form

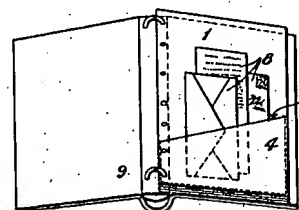
*Fig. 1.*



*Fig. 2.*



*Fig. 3.*



“a two ply pocket” with a closed end, wherein the pocket sheet and the base sheet are separate sheets; and wherein a front and back cover are used to bind the inserts together, and wherein the pockets are used to retain supplemental media (8).

Applicant first notes that in order to make use of the Dick disclosure to establish a “two ply pocket”, the Examiner refers to the structure of Dick “at a particular location.”

Looking at only “a particular location” of the reference would appear to be ignoring the teachings of the reference as a whole.

By looking at only “a particular location” of the reference, the Examiner is selecting a portion of the Dick disclosure while disregarding that Dick, in fact, discloses a double pocket that is *three* plies thick.

At all locations where there is a pocket, the Dick structure is three plies thick (see Figure 2). Ignoring the three plies of Dick is to ignore the teaching of the reference taken as a whole.

Applicant further respectfully disagrees with the Examiner’s characterization of Dick disclosing “any” securing means for attaching the pocket sheet to the base sheet.

The recitation in Dick of securing means is not enabling for the specifically recited connections set forth in Claims 1-9, 11-13 and 16-18. The words “securing means” do not provide the recited chemical bonding, fused or glued constructions of the present claims.

The Examiner concludes it would have been obvious “to modify Wyant’s pocket insert to include a separate pocket sheet attached to the base sheet to form a pocket insert, wherein the sheets are attached by any securing means and wherein the inserts retain supplemental media and are bound between two covers as taught by Dick for the purpose of providing a more secured pocket.”

The asserted obvious combination renders the primary reference Wyant inoperable for its intended purpose. That is, Wyant is expressly directed to

providing tabs 12a, 12b and 12c which can be selectively folded outward of the edge of the card. (Col. 1, lines 46-48). The only way in which these tabs can be formed, is upon forming the tab yielding sheet and the base sheet from a single piece of material to include a fold line. In contrast, the Examiner now asserts it would be obvious to use separate sheets of material as shown in Dick. However, using separate sheets of material would render the express and claimed tab forming function of Wyant inoperative.

#### *APPLICABLE LAW AND STANDARDS*

“Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. [citations omitted] *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. [citations omitted] *Id.* at 1317.

The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. Broad conclusory statements standing alone are not “evidence.” [citations omitted] *Id.* at 1317.

“Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing

of a teaching or motivation to combine the prior art references. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." [citations omitted] *Ecolchem v. Southern California Edison Co.*, 56 USPQ2d 1065, 1073 (Fed. Cir. 2000).

"Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *Id.* at 1073 "The opinion then lists each step and states where in the cited prior art references the step can be found. This reference-by-reference, limitation-by-limitation analysis wholly fails to demonstrate how the prior art teaches or suggests the combination claimed in the '411 patent." *Ecolchem* at 1075.

The Federal Circuit has stated the "implicit generalized finding by a district court that when one of ordinary skill was faced with a problem [of the patent] in view of a prior art reference, that the combination claimed would have been obvious is insufficient." *Ecolchem* at 1075.

"A rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention would have selected these components for combination in the manner claimed." *Ecolchem* at 1076.

"In *In re Dembiczak*, we noted that:

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

We "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re*

*Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988). *Ecolochem* at 1072.

*Claims 1-4, 6, 7, 9, 11-13, and 16-18*

Claim 1 recites in part:

(a) “a base sheet of paper material having a length and width comparable to the length and width of a book page comprising a binding edge bound to the binding . . .”

(b) “a pocket sheet of paper material being one ply, the pocket sheet having ...a perimeter defined by an attached edge section on the inner surface and a free edge section on the inner surface” and the attached edge section forming “continuous two ply seams defining a closed pocket” and

“wherein the base sheet and a pocket sheet are arranged such that the pocket opening faces the binding.”

Wyant discloses an inherently different attachment mechanism, as top and bottom margin panels 26, 28 are secured to the tab yielding panel 11, which in turn overlies the base 22, thereby forming a three layer thickness and does not provide “one of chemically bonding, bonded, fused or glued” the first surface of the base sheet to the attached edge section. Nor does the Wyatt structure provide “continuous two ply seams” as claimed.

As expressly recited by Wyant, the top marginal panel and the bottom marginal panel are secured to the tab yielding panel 11. (Col. 2, lines 59-61). There is no disclosure or suggestion of affixing the “inner surface” of the tab yielding panel 11 to the “top planar surface” of the base 22.

Dick cannot cure the deficiencies of Wyant. That is, as suggested by Examiner, forming Wyant to include a separate pocket sheet would preclude Wyant from forming the tabs. Further, modification of the secondary reference Dick to provide the pocket opening towards the binding edge would be expressly contrary to allowing that “the letters are inserted in a vertical position, thereby

enabling the observer to read the titles without it being necessary to turn the book around to different positions." (Page 1, lines 93-96)

Dick is directed to having the pocket opening not face the binding edge.

It should be observed that the arrangement of the pockets at the lower portion of the sheet is such that the letters are inserted in a vertical position, thereby enabling the observer to read the titles without it being 95 necessary to turn the book around into different positions. (Col. 2)

Rearranging the pocket as asserted by the examiner would be directly contrary to the express purpose of the primary reference.

Further, Dick states:

This improvement relates to improvements 10 in loose leaf sheets for use in loose leaf binders, and having pockets on the opposite sides or faces thereof, whereby as the sheet is turned in the binder from one side to the other, the pockets are rendered accessible 15 for readily placing articles therein and removing them therefrom. (Col. 1)

"We have noted as a "useful general rule," that references that teach away cannot serve to create a prima facie case of obviousness. In re Gurley, 27 f.3d 551, 553, 31 U.S.P.Q. 2d 1131, 1132 (Fed. Sur. 1994)" McGinley v. Franklin Sports Inc., U.S.P.Q. 2d 1001, (Fed. Sur. 2001).

Accordingly, since Dick does not cure the Wyant defects, and in view of the Examiner's improper reliance upon the Dick "at a particular location" rather than upon the disclosure as a whole, Applicant respectfully submits Claims 1-4, 6-7, 9, 11-13, and 16-18 are in condition for allowance.

### *Claim 5*

Claim 5 depends from Claim 1, and further recites in part “the base sheet and the pocket sheet are formed of separate sheets of paper material that are adhered to one another along the attached edge section of the pocket sheet.”

If Wyant were formed of separate sheets of material for the tab yielding panel 11 and the base sheet 22, and were secured as set forth by Wyant, there could be no formation of the tabs. That is, upon forming the ruptureable tear line 16 for formation of the tab 12, once the tab 12 were separated from the tab yielding panel 11, the tab would fall off.

As this is so expressly contrary to the intended purpose of the primary reference, applicant respectfully submits the asserted rejection of Claim 5 cannot be sustained.

### *Claim 8*

Claim 8 depends ultimately from Claim 1 and further recites “the base sheet and the pocket sheet are adhered to one another along their respective first edges, third edges and fourth edges.”

Wyant requires the tab yielding sheet 11 be free from the base sheet 22 in order for the tabs to separate from the base sheet and project from the common periphery of the file marker. Further, the Examiner has not identified any specific suggestion in either of the references for this modification. Therefore, as the structure of Claim 8 is directly contrary to the proposed modification of the primary reference, Applicant submits the rejection of Claim 8 cannot be sustained.

### *Claim 32*

Independent Claim 32 recites in part that pocket insert comprising

- (a) “a base sheet having a planar first surface . . .

(b) “a pocket sheet having a planar inner surface . . . the attached edge section being attached to the first surface of the base sheet along a continuous seam to form a closed end pocket . . .” ; and

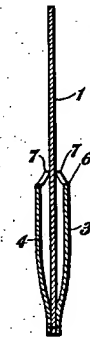
“wherein the base sheet and a pocket sheet are arranged such that the pocket opening faces the binding and the pocket insert as a total thickness less than a combined thickness of the base sheet, the pocket sheet and one of the base sheet and pocket sheet rendering the insert passable through a copier in sequence with a sheet of paper.”

Applicant repeats the argument made above that the Examiner has improperly selected a disclosure of Dick “at a particular location” to combine with the Wyant disclosure.

Applicant also repeats the argument that nothing in Wyant (or in Dick) suggests or renders obvious a pocket insert having a total thickness as claimed “rendering the insert passable through a copier or printed in sequence with a sheet of paper.”

In addition, the proposed combination of Wyant and Dick not only provides an inoperable primary reference (Wyant) but still includes a device having a thickness which is at least equal to the combined thickness of the base sheet, the pocket sheet and one of the base sheet and the pocket sheet. Specifically, as seen in Figure 1 of Wyant, the corners are formed by base sheet 22, top marginal panel 28 and panel 50. Thus, the Wyant device, outside of the tab forming feature provides for a three layer thickness (in addition to any adhesives employed). As seen in Dick, the resulting structure also has at least three layers of thickness.

*Fig. 2.*



The Examiner discounts the limitation on Claim 32 that the thickness of the insert renders it passable through a copier or printer as being merely a recitation of intended use.

As noted above with respect to Claim 35, the thickness recitation here adds a structural limitation and Applicant points out that there is no mention



whatsoever of the Michelin pocket insert being printed or being passable through a printer in its assembled state (i.e. folded as shown in Figure 1 to form a file folder.

As neither the primary nor the secondary reference disclose or suggest the set of limitations of Claim 32, Applicant respectfully submits the rejection of Claim 32 under 35 U.S.C. §103 is not sustainable.

#### *Claim 33*

Claim 33 depends from independent Claim 32 and further states in part “the maximum number of pocket sheet thicknesses and the maximum number of base sheet thicknesses at any location of the pocket insert is one.”

As both the primary reference Wyant (which discloses at least four locations which have a three layer thickness - two layers of the base with one layer of the tab yielding, or three layers of the base) and Dick has three layers - two pocket sheet thicknesses in combination with one base sheet thickness. The Examiner’s asserted rejection as being “an obvious matter of design choice” is not sustainable.

That is, as set forth in the present specification by limiting the thickness of the present invention, it can find applicability in standard single sheet paper processing devices.

Further, the Examiner has provided no specific suggestion for this “obvious design choice.”

To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making a specific combination that was made by the applicant. *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1333, 1361 (Fed. Cir. 2000).

Not only are the elements not present in the cited references, the elements are contrary to the cited references. Further, the Examiner has not provided any motivation or suggestion or teaching, absent applicant’s disclosure

for making the asserted combination. Therefore, this rejection cannot be sustained.

*Claim 34*

Independent Claim 34 recites in part a pocket insert comprising

“(a) a base sheet having a planar first surface . . . and a binding edge selected to be bound at the bound edge;

(b) a pocket sheet having a planar inner surface . . . a portion of the inner surface of the pocket connected to the first surface of the base sheet along a continuous seam to form having a pocket opening between the first surface of the base sheet and the inner surface of the pocket sheet, the pocket opening facing the binding edge; and

(c) the pocket insert having a thickness rendering it passable through a copier or printer in sequence with a single sheet.”

The asserted connection of the first surface of the base sheet to the inner surface of the pocket sheet is contrary to the primary reference Wyant. Further, the pocket opening facing the binding edge is directly contrary to Dick.

The thickness limitation adds structure to the insert in that it establishes a thickness of the insert that makes it compatible the thickness of a sheet that is handled by a copier or printer.

This structural limitation is neither disclosed nor suggested by either of Wyant or Dick.

In view of the reasons set out above, applicant respectfully submits this rejection should be reversed.

*Claim 36*

Independent Claim 36 recites in part a pocket insert comprising

“(a) a base sheet having a planar first surface . . .

(b) a pocket sheet having a planar inner surface . . . a portion of the inner surface of the pocket sheet connected to the first surface of the base sheet to

form a seam of two plies defining (i) a first pocket having a first pocket opening between the first surface of the base sheet and the inner surface of the pocket sheet, the first pocket opening facing the binding edge, and (ii) a second pocket having a second pocket opening between the first surface of the base sheet and the inner surface of the pocket sheet, the second pocket opening facing the binding edge; and

(c) the pocket insert having a thickness rendering the insert passable through a copier or printer in sequence with a sheet of paper having a width and length comparable to the base sheet width and length.”

Neither Wyant nor Dick cited in the rejection of Claim 36 disclose the recited pocket sheet being bound to the base sheet along seams of two plies to define first and second pocket openings, each pocket opening facing the binding edge.

The added reference, Ruebens (US 4, 965, 948) cited as disclosing this feature, in fact discloses an arrangement similar to Dick in that the seams forming the Rueben pockets are three plies thick.

Seams of two plies are only seen at a particular portion of the Ruebens structure when the back-to-back structure of the Ruebens display page is ignored (see Figures 4 and 5).

Accordingly, the Examiner again is picking and choosing only a portion of the Ruebens disclosure that suits the asserted rejection while ignoring the teachings of the reference as a whole.

Also, the recital thickness limitation makes it clear that the entire insert is of a thickness allowing the insert to pass through a printer or copier in sequence with a single sheet having the same length and width dimensions as the insert base sheet.

This structural limitation is neither disclosed nor rendered obvious by either Wyant, Dick or Ruebens taken separately or in combination.

The Examiner in discussing Claim 36 says “the pocket insert of Michelin is capable of being passable through a printer in sequence with a sheet of paper.” This is not understood, as Michelin has not been cited in the rejection of Claim 36.

If it was the intent of the Examiner to say that any one of the Wyant, Dick or Reubens structures is passable through a printer in sequence with a sheet of paper, then such a conclusory statement finds no support in any of these references. There is no suggestion that the three ply structures of these references (considering that the Wyant seams are three plies) are passable through a printer or copier let alone passable in sequence with a sheet having the length and width of a sheet as claimed.

Further, the Examiner has not identified any specific teaching in either reference to suggest such modification. Therefore, Claim 36 is in condition for allowance.

*Claims 10, 14, 15 19-21*

Claims 10, 14, 15 19-21 and 24 stand rejected under 35 U.S.C. §103 over Wyant in view of Dick and further in view of Ruebens (US Patent 4,965,948).

The Examiner asserts it would have been obvious to modify Wyant and Dick’s pocket insert to include an adhesive strip as taught by Ruebens for the purpose of defining a plurality of pockets to hold numerous items. [Paper 16, page 5]

*Claims 10, 14, 15 and 19-21*

Claims 10, 14, 15 and 19-21 ultimately depend from Claim 1 and include all the limitations thereof.

Applicant reasserts the arguments made in response to the rejection of Claim 1. Ruebens does not cure the deficiencies of the asserted combination of Wyant in view of Dick. That is, each of these claims recite in a part “a base sheet of paper material” and “a pocket sheet of paper material.” The Examiner has not provided a basis for picking and choosing from the disclosure of Ruebens. The

transparent plastic album cover 22 of Ruebens does not suggest the recited paper material. Therefore, these claims are in condition for allowance.

*Claim 24*

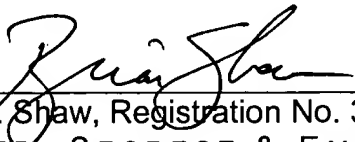
Claim 24 depends from Claim 22, and further recites in part "wherein the base sheet and the pocket sheet are further adhered to one another along a strip parallel to the third and fourth edges of the sheets, so as to separate two pockets formed between the sheets."

As Claim 24 depends from Claim 22 and includes all the limitations thereof, applicant respectfully reasserts the arguments made in response to the rejection of Claim 22. Again, the independent claim recites a base sheet and a pocket sheet of paper material. The transparent plastic album cover of Ruebens does not cure the deficiencies of the primary references.

CONCLUSION

Therefore, applicant respectfully submits all the Claims are subject to the present appeal, namely Claims 1-21 and 32-36 are in condition for allowance and respectfully requests the outstanding rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) be reversed.

Respectfully submitted,

  
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Date: November 8, 2003

APPENDIX – CLAIMS INVOLVED IN APPEAL

1. A book comprising multiple pages and a pocket insert bound along a binding, wherein the pocket insert comprises:

(a) a base sheet of paper material having a length and width comparable to the length and width of a book page, the base sheet comprising a binding edge bound to the binding, the base sheet being one ply and having a planar first surface and a planar second surface; and

(b) a pocket sheet of paper material being one ply, the pocket sheet having a planar inner surface, a planar outer surface, and a perimeter defined by an attached edge section on the inner surface and a free edge section on the inner surface, at least a portion of the attached edge section being one of chemically bonded, fused or glued to the first surface of the base sheet to form continuous two ply seams defining a closed pocket and the free edge section being unattached to the base sheet to form a pocket opening along the free edge section between the first surface and the inner surface of the pocket sheet,

wherein the base sheet and the pocket sheet are arranged such that the pocket opening faces the binding.

2. The book of claim 1, wherein the pocket opening extends substantially parallel to the binding edge of the base sheet.

3. The book of claim 1, wherein the pocket sheet has a width smaller than a width of the base sheet but at least half the width of the base sheet.

4. The book of claim 3, wherein the pocket sheet has a width at least 60 percent of the width of the base sheet.

5. The book of claim 1, wherein the base sheet and the pocket sheet are formed of separate sheets of paper material that are adhered to one another along the attached edge section of the pocket sheet.

6. The book of claim 1, wherein the base sheet comprises:
- a first edge,
  - a second edge opposed to the first edge and defining the binding edge,
- the first and second edges defining a width of the base sheet, and
- third and fourth edges opposed to one another and disposed between the first and second edges, the third and fourth edges defining a length of the base sheet.
7. The book of claim 6, wherein the pocket sheet comprises:
- a first edge attached to the base sheet,
  - a second edge opposed to the first edge, the first and second edges defining a width of the pocket sheet, at least a portion of the second edge being unattached to the base sheet for forming the pocket opening, and
  - third and fourth edges opposed to one another and disposed between the first and second edges, the third and fourth edges defining a length of the pocket sheet and being attached to the base sheet; wherein the pocket sheet has a shorter width than the base sheet.
8. The book of claim 7, wherein the base sheet and the pocket sheet are adhered to one another along their respective first edges, third edges and fourth edges.
9. The book of claim 7, wherein the first edges of the base sheet and the pocket sheet are parallel to the second edges of the respective sheets, and the third edges of the base sheet and the pocket sheet are parallel to the fourth edges of the respective sheets.
10. The book of claim 9, wherein the base sheet and the pocket sheet are further adhered to one another along a strip parallel to the third and fourth edges of the sheets, so as to separate two pockets formed between the sheets.

11. The book of claim 7, wherein the base sheet and the pocket sheet are formed of a single section of paper material.

12. The book of claim 11, wherein the single section is folded along a fold line defining the first edges of the base sheet and the pocket sheet.

13. The book of claim 7, wherein the pocket sheet first edge is attached to the base sheet with an adhesive proximate to the base sheet first edge, the pocket sheet third edge is attached to the base sheet with an adhesive proximate to the base sheet third edge, and the pocket sheet fourth edge is attached to the base sheet with an adhesive proximate to the base sheet fourth edge.

14. The book of claim 13, wherein the pocket sheet is attached to the base sheet with an adhesive along a strip extending widthwise between the third and fourth edges of the sheets.

15. The book of claim 14, wherein the widthwise strip separates two pockets formed by the base sheet and the pocket sheet, both pockets opening towards the base sheet first edge.

16. The book of claim 1, wherein the base sheet is formed of a rectangular sheet of paper having a length of about 11 inches and a width of 8 to 8.5 inches.

17. The book of claim 16, wherein the pocket sheet is formed of a rectangular sheet of paper having a length of about 11 inches and a width of 5 to 6 inches.

18. The book of claim 17, wherein the multiple pages are rectangular sheets having a length of about 11 inches and a width of about 8.5 inches.



19. The book of claim 1, further comprising a front cover and a back cover bound along the binding, the pages and pocket insert being disposed between the front and back covers.

20. The book of claim 19, further comprising supplemental media retained in the pocket.

21. The book of claim 15, further comprising supplemental media retained in both pockets.

32. A pocket insert configured to be bound along a binding, the pocket insert comprising:

- (a) a base sheet having a planar first surface, a planar second surface and a binding edge selected to be bound to the binding; and

- (b) a pocket sheet having a planar inner surface, a planar outer surface, a perimeter defined by an attached edge section on the inner surface and a free edge section on the inner surface, the attached edge section being attached to the first surface of the base sheet along a continuous seam to form a closed end pocket and the free edge section being unattached to the base sheet to form [a pocket with] a pocket opening along the free edge section and the first surface of the base sheet,

wherein the base sheet and the pocket sheet are arranged such that the pocket opening faces the binding and the pocket insert has a total thickness less than a combined thickness of the base sheet, the pocket sheet and one of the base sheet and the pocket sheet rendering the insert passable through a copier or printer in sequence with a sheet of paper.

33. The pocket insert of Claim 32, wherein a maximum number of pocket sheet thicknesses and the maximum number of base sheet thicknesses at any location of the pocket insert is one.

34. A pocket insert for binding along a bound edge, comprising:

- (a) a base sheet having a planar first surface and a planar second surface, and a binding edge selected to be bound at the bound edge;
- (b) a pocket sheet having a planar inner surface and a planar outer surface, a portion of the inner surface of the pocket sheet connected to the first surface of the base sheet along a continuous seam to form a pocket having a pocket opening between the first surface of the base sheet and the inner surface of the pocket sheet, the pocket opening facing the binding edge; and
- (c) the pocket insert having a thickness rendering it passable through a copier or printer in sequence with a sheet of paper.

35. An improved pocket insert for operably passing through a printer or a copier in sequence with a single sheet of paper having a given width and a given length, the improvement comprising:

- (a) a base sheet having a single thickness and a binding edge located at an end of the sheet, the base sheet having a width equal to the given width and a length equal to the given length;
  - (b) a pocket sheet having a single sheet thickness;
  - (c) an adhesive between the base sheet and the pocket sheet to bond the base sheet to the pocket sheet to form a pocket with an opening facing the binding edge,
- the pocket insert having a thickness rendering the insert passable through a copier or printer in sequence with a sheet of paper having the given width and length, the thickness of the pocket insert being at its maximum equal to a combined thickness of the base sheet single thickness, the pocket sheet single sheet thickness and the adhesive.

36. A pocket insert of two sheets for binding along a bound edge, comprising:

- (a) a base sheet of a given length and width having a planar first surface and a planar second surface, and a binding edge selected to be bound at the bound edge;

(b) a pocket sheet having a planar inner surface and a planar outer surface, a portion of the inner surface of the pocket sheet connected to the first surface of the base sheet to form a seam of two plies defining (i) a first pocket having a first pocket opening between the first surface of the base sheet and the inner surface of the pocket sheet, the first pocket opening facing the binding edge, and (ii) a second pocket having a second pocket opening between the first surface of the base sheet and the inner surface of the pocket sheet, the second pocket opening facing the binding edge; and

(c) the pocket insert having a thickness rendering the insert passable through a copier or printer in sequence with a sheet of paper having a width and length comparable to the base sheet width and length.



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